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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,939	03/11/2004	Charles B. Worrick III	00216-664001 / Case 8134	8003

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EXAMINER

MICHALSKI, SEAN M

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

Office Action Summary	Application No. 10/799,939	Applicant(s) WORRICK ET AL.	
	Examiner Sean M. Michalski	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-10,12,13,15,18-21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7-10,12,13,15,18-21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 12/19/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "only along a leading edge of the button substrate" which was added to claims 1 and 10.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3, 7-10, 12, 13, 15, 18-21, and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "only along a leading edge of the button substrate" is without support in the specification. There is no leading edge defined, and the flexible canopy is not touching the button substrate as disclosed (see figure 42), which makes determination of the "leading edge" which the canopy "buckles along" impossible without a supporting disclosure. Element 200 is the canopy, which is in contact with element 196, but not

element 198. Element 198 is disclosed as the 'button substrate' completely contained within 196 as seen in figures 42 and 43.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 7-10, 12, 13, 15, 18-21, and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "only along a leading edge of the button substrate..." is indefinite, since it is unascertainable what the leading edge of the button substrate is, and since it is unclear whether the canopy can "buckle only along" that leading edge. "Only" compared to what? The canopy buckles along surface 306 also, and it buckles along the button 196. It is not clear how the canopy can buckle *only* along the leading edge of the button substrate, when there is an element between the canopy and the substrate, and there is an opposed surface which is also along where the canopy buckles. The limitation is indefinite.

Additionally it is unclear what constitutes a button substrate, since no definition is provided. It is difficult to render a patentability determination regarding limitations relating to an undefined, and broad term such as "button substrate" where it is not clear from the claim ("along a leading edge of the button substrate") or the specification what elements constitute (and therefore, would infringe upon) a button substrate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 7-10, 13, 15, 18-21, 25 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Apprille'071 in view of Kirk (USPN 3,048,673).

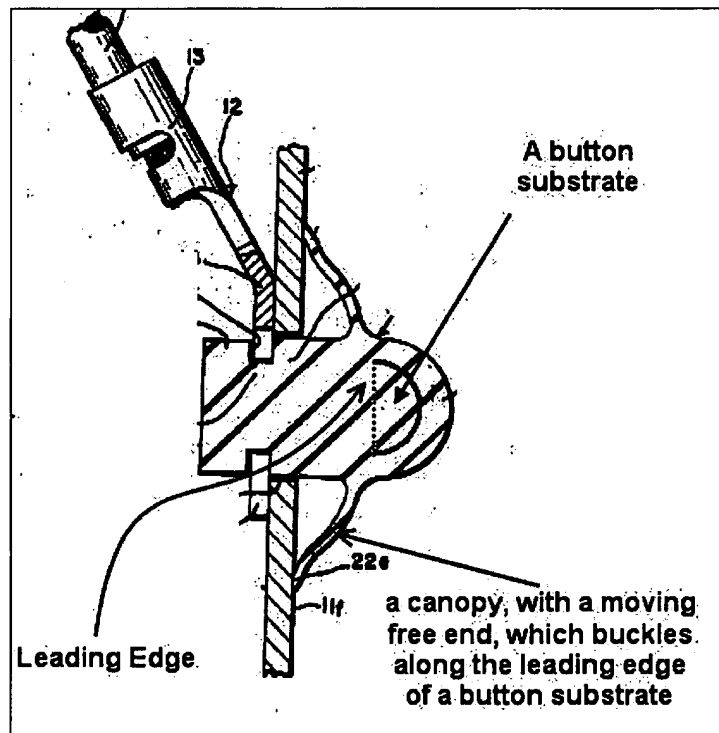
Apprille'071 teaches a cartridge (#14 figure 1) with a blade unit including a housing (#16 figure 1) that carries one or more shaving blades (#18 figure 1), a handle (#30, figure 3) with a handle casing (#42, figure 3), an interconnect assembly disposed at an end of the handle casing (#26, figure 3), a release button comprising a button substrate (since applicant has not defined or recited what is meant by substrate, the broadest reasonable interpretation must be applied: any portion of a button interior of the exterior surface is rightly construed as a button substrate) and a flexible canopy (50) extending outwardly from the button substrate toward the handle casing (#50, figure 3). Apprille'071 further teaches that the edge of the canopy contacts the handle casing (#50 is in contact with #12, figures 16 & 17). Apprille'071 further teaches that the edge of the canopy contacts the handle casing when the button is in an unloaded position (#50 is in contact with #12, figures 16 & 17). Apprille'071 further teaches that the edge of the canopy contacts the handle casing when the button is in an actuated position (#50 is in contact with #12, figures 16 & 17). Apprille'071 further teaches that the edge of the canopy contacts the handle casing having an angle of no greater than 110 degrees.

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This is because the angle formed between the button and the handle casing varies and is at a maximum in the front center region of the canopy, which at no time is greater than 110 degrees (#50 is in contact with #12, figures 16 & 17). The angle between the canopy and the handle casing wall varies from about 50 degrees to about 110 degrees.

Aprille'071 does not teach that the flexible canopy buckles during actuation, and returns to an unbuckled state after actuation.

Kirk discloses a button as seen in the figure below:



In the same field of problem solving endeavor (concealing part of an interconnect assembly of a button) it would have been obvious to one skilled in the art at the time of the invention to modify Aprille'071 by making the canopy buckle only along a leading edge of the button substrate during actuation, as taught by Kirk. The motivation to combine is that both canopies conceal an interconnect assembly, and so it

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would have been an obvious design choice to select a buckling canopy over a non-buckling canopy. The choice of canopy has no impact on the ability to "conceal at least part of an interconnect assembly". The substitution of one known button mechanism for another is within the level of ordinary skill in the art.

Regarding claims 25 and 26, Aprille'071 in view of Kirk does not teach that the canopy be between .3 and .6 mm thick, however this limitation lacks criticality. The specification merely states this range as follows: "The thickness of the canopy can be between about 0.3 mm and 0.6 mm". No reason or rationale is provided, nor is the limitation of between .3 and .6 mm in any way essential to the function of the canopy which is to conceal the connecting assembly. A thickness of .1mm or 1mm would conceal just as effectively.

Alternatively, it would have been obvious to provide the canopy with a thickness of between 0.3mm and 0.6mm because it has been held that it is routine in the art to discover an optimum value of a result effective variable.

5. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Aprille'071 in view of Kirk as applied to claims 1 and 13 above and further in view of Jones et al. (USPN 6,898,855).

Jones et al teaches the use of thermoplastic elastomer in buttons for gripping by the hand. (Col. 8 lines 1-5). It would have been obvious to one skilled in the art at the time of the invention to use thermoplastic elastomer, since it has been known to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin*, 125 USPQ 416. The motivation to combine is to provide a more ergonomic grip as disclosed in Jones et al. (col. 4 lines 5-15).

Response to Arguments

6. Applicant's arguments filed 12/19/2007 have been fully considered but they are not persuasive.

Applicant has added the limitation, "the flexible canopy buckles only along a leading edge of the button substrate". This limitation, as seen in the rejection above, is found in the prior art of record.

Furthermore, the limitations dealing with the buckling of the canopy have a decided lack of criticality. The only function which the canopy serves is to "conceal at least a part of an interconnecting assembly" (applicant's specification page 2, line 4), which the prior art of record clearly performs. The function of concealing is not achieved by the buckling, but by the presence of the canopy. Should applicant receive a grant of patent rights on the basis of a limitation which does not relate to the problem being solved? The consistent answer from the courts is, No. Where a limitation lacks criticality, a patent should not be granted. See *In re Kuhle* 188 USPQ 7 (CCPA 1975) "use of such a means...in lieu of those used in the references solves no stated problem

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and would be an obvious matter of design choice within the skill of the art.” Also see Anderson’s Black Rock, Inc. v. Pavement Salvage Co., Inc., 163 USPQ 673 (S. Ct. 1969) which states “the presence of the radiant burner in the same machine with the other elements is not critical or essential *to the functioning* of the radiant burner *in curing the problem* of the cold joint” (emphasis added). Similarly, applicant has stated a purpose for the canopy; namely, to “conceal at least part of an interconnecting assembly” which the prior art of record does. To add additional limitations, unnecessary to the solution of the problem, will not support a showing of non-obviousness. In Anderson’s Black Rock, the court stated that “the convenience of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a “new or different function” ” (citing to Lincoln Co. v. Stewart Warner Corp., 303 U.S. 545, 549, 37 USPQ 1, 3.) . Applicant is in a similar situation, having provided known materials and mechanisms together, producing no “new or different function” and solving no problem not also solved by the prior art. Applicant has not given any evidence of criticality for the canopy besides that which is clearly already shown in the prior art (Aprille’071 alone conceals the interconnect assembly), and has shown no criticality at all for the buckling limitations of the canopy.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S M M



KENNETH E. PETERSON
PRIMARY EXAMINER